

Application No. 09/874,126

IN THE DRAWINGS:

Please amend Figures 1 and 3 as illustrated in red on the attached photocopies.

REMARKS

Claim Rejections

Claims 1-18 are rejected under 35 U.S.C. § 112, first paragraph. Claims 1-18 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1, 3, 5, 7-8 and 10 are rejected under 35 U.S.C. §102(b) as being anticipated by Blinn et al. (U.S. 5,897,622). Claim 11 is rejected under 35 U.S.C. §102(b) as being anticipated by Blinn et al. Claim 18 is rejected under 35 U.S.C. §102(b) as being anticipated by Blinn et al. Claims 2, 12 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Blinn et al. in view of Robinson et al. (U.S. 5,941,648). Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Blinn et al. in view of Costello et al. (U.S. 6,754,894). Claims 6 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Blinn et al. in view of Chebil et al. (U.S. 6,760,481). Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Blinn et al. in view of Lowell et al. (U.S. 6,282,265). Claims 13-14 are rejected under 35 U.S.C. §103(a) as being anticipated by Blinn et al. and Robinson et al. in view of Costello et al. Claims 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Blinn et al. in view of Gaus et al. (U.S. 6,343,277).

Substitute Specification

As required by the Examiner, a Substitute Specification is enclosed, along with a marked-up copy of the original specification indicating the changes made thereto by the Substitute Specification. No "new matter" has been added to the original disclosure by the Substitute Specification. Entry of the Substitute Specification is respectfully requested.

Abstract of the Disclosure

Applicant is submitting a substitute Abstract of the Disclosure for that originally filed with this application to more clearly describe the claimed invention. Entry of the Substitute Abstract of the Disclosure is respectfully requested.

Drawings

Applicant proposes to amend Figures 1 and 3, as illustrated in red on the attached photocopies. In Figures 1 and 3 it is proposed to change "Servo" to read --Server--. No "new matter" has been added to the original disclosure by the proposed amendments to these figures. It is believed the foregoing proposed amendments obviate the outstanding objections to the drawings. Approval of the proposed drawing changes is respectfully requested.

New Claims

By this Amendment, Applicant has canceled claims 1-18 and has added new claims 19-36 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

It is submitted that the claimed subject matter is described in Applicant's specification in sufficient detail to enable one having ordinary skill in the art to make and use Applicant's invention without undue experimentation. It is believed that Applicant's specification discloses how to make and use the claimed invention.

The primary reference to Blinn et al. teaches an electronic shopping and merchandising system having a client (100) connecting to a sever (102) through a network (104).

Blinn et al. do not teach the personal digital assistant receiving the catalogue data actively transferred via an active wireless transmission from the transmission interface utilizing a one-to-many mode.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Blinn et al. do not disclose each and every feature of Applicant's new claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Blinn et al. cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

The secondary reference to Robinson et al. teaches a personal digital assistant having a foldable key board component and is cited for teaching the personal digital assistant having a display screen, a direction selection unit, input key, and sensor pen.

Robinson et al. do not teach the personal digital assistant receiving catalogue data; nor do Robinson et al. teach the personal digital assistant receiving the catalogue data actively transferred via an active wireless transmission from the transmission interface utilizing a one-to-many mode.

The secondary reference to Costello et al. teaches wireless software and is cited for teaching an application specific integrated circuit (ASIC).

Costello et al. do not teach the personal digital assistant receiving catalogue data; nor do Costello et al. teach the personal digital assistant receiving the catalogue data actively transferred via an active wireless transmission from the transmission interface utilizing a one-to-many mode.

The secondary reference to Chebil et al. teaches a system for processing image data and is cited for teaching a trellis classifying structure.

Chebil et al. do not teach the personal digital assistant receiving catalogue data; nor do Chebil et al. teach the personal digital assistant receiving the catalogue data actively transferred via an active wireless transmission from the transmission interface utilizing a one-to-many mode.

The secondary reference to Lowell et al. teaches a two-ended wireline pair identification system and is cited for teaching a series number.

Lowell et al. do not teach the personal digital assistant receiving catalogue data; nor do Lowell et al. teach the personal digital assistant receiving the catalogue data actively transferred via an active wireless transmission from the transmission interface utilizing a one-to-many mode.

The secondary reference to Gaus et al. teaches an energy network commerce system and is cited for teaching users (76, 78, 80) accessing a network (32) through ISP (82, 84, 86) connected to the internet (40); and an application specific integrated circuit.

Gaus et al. do not teach the personal digital assistant receiving catalogue data; nor do Gaus et al. teach the personal digital assistant receiving the catalogue

data actively transferred via an active wireless transmission from the transmission interface utilizing a one-to-many mode.

Even if the teachings of Blinn et al., Robinson et al., Costello et al., Chebil et al., Lowell et al., and Gaus et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: the personal digital assistant receiving the catalogue data actively transferred via an active wireless transmission from the transmission interface utilizing a one-to-many mode.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the

claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Blinn et al., Robinson et al., Costello et al., Chebil et al., Lowell et al., or Gaus et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Blinn et al., Robinson et al., Costello et al., Chebil et al., Lowell et al., nor Gaus et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Application No. 09/874,126

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: June 9, 2005

By:



Bruce H. Troxell
Reg. No. 26,592

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707